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April 11, 2005

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Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**Art Unit 1634**

Re: U.S. Utility Patent Application  
Application No. 09/741,664; Filed: December 21, 2000  
For: **Stable Compositions for Nucleic Acid Amplification and Sequencing**  
Inventors: Rashtchian *et al.*  
Our Ref: 0942.3910003/BJD/SAC

Sir:

Transmitted herewith for appropriate action are the following documents:

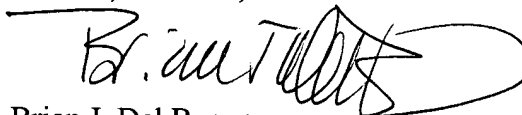
1. Reply To Requirement For Election of Species; and
2. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Rashtchian *et al.*

Appl. No.: 09/741,664

Filed: December 21, 2000

For: **Stable Compositions for Nucleic  
Acid Amplification and Sequencing**

Confirmation No.: 7736

Art Unit: 1634

Examiner: Sitton, Jehanne S.

Atty. Docket: 0942.3910003/BJD/SAC

**Reply to Requirement For Election of Species**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated March 9, 2005, requiring an election of a single specific polymerase recited in claims 5 or 6, Applicants hereby provisionally elect *Taq* DNA polymerase. Applicants believe that claims 1-3, 5, 8-13, 26, 28-31, 33, 35, 37-39, 44-47, 54-55, 57, and 59 read on the provisionally elected species. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with traverse**. Applicants respectfully assert that the issuance of the election of species requirement is not justified. The Examiner contends that "the amendment to generic claims 1-3 . . . has changed the scope of the dependent claims 5-23. The search for the generic compositions comprising one or a combination of polymerases set forth in claims 5-23 is extremely burdensome and not co-extensive, as each polymerase has to be searched independently." Office Action at page 2.

Applicants respectfully disagree with these contentions for at least the following reasons. First, the elements added to the independent claims represent an incorporation of these same elements from certain dependent claims, which have already been

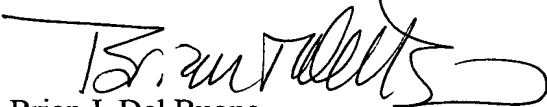
examined in this application. Second, claims reciting each of the allegedly distinct species of polymerases have been pending since the present application was first filed over four years ago. Given that these claims have been the subject of multiple Office Actions, containing numerous art citations, one would expect that all of the DNA polymerases, now alleged to be distinct species, have already been fully searched and examined. Furthermore, the Examiner has previously issued a restriction requirement in the present application, which *did not* include an election of species requirement. *See* Restriction Requirement dated 11/18/02. The Examiner then withdrew the restriction requirement "in view of the claims having been searched in a parent application." *See* Office Action dated 11/5/2003 at page 2.

Therefore, for at least the above reasons, Applicants respectfully submit that there would be no new excessive burden imposed upon the Examiner to search and examine the DNA polymerases recited in the present claims if election were not required. In view of the foregoing remarks, reconsideration and withdrawal of the Requirement for Election of Species, and consideration and allowance of all pending claims, are respectfully requested.

It is believed that extensions of time are not required, beyond those that may otherwise be provided for in accompanying documents. However, in the event that additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefore are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

  
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Date: April 11, 2005

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